

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

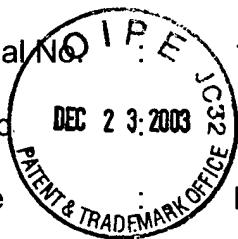
Docket No.: ATM-2360

Applicant : Joseph WITTEMER

Serial No. 1 P E 10/692,682

Filed DEC 23 2003 October 27, 2003

Title PACKAGING BAG



DECLARATION

Virgil H. Marsh declares and states that:

- (1) He is a patent attorney registered before the U.S. Patent Office.
- (2) He is a partner in the firm of Fisher Christen & Sabol, 1725 K St. N.W., Suite 1106, Washington, D.C. 20006.
- (3) On October 7, 2003 his office received an order dated October 2, 2003, sent via air carrier by Mr. Hans Burkhart to file a U.S. patent application by the one-year priority due date of December 12, 2003. Mr. Burkhart's order letter stated that the U.S. patent application was to be based on the original European Patent Application No. 02406095.6, filed on December 12, 2002. The order letter also stated that the sole inventor was Mr. Joseph Wittemer, a U.S. citizen, residing at 4202 Patterson Park Court, Louisville, KY 40299. His office acknowledged receipt of the order by fax and docketed the due date.
- (4) Mr. Burkhart is a patent agent in Switzerland and is also a European patent attorney. He is not a (registered) U.S. patent agent or attorney. Mr. Burkhart is employed as head of the Intellectual Property (Patent) department of Alcan Technology & Management Ltd., that is a Swiss corporation having a place of business at Badische Bahnhofstrasse 16, CH-8212 Neuhausen am Rheinfall, Switzerland. Alcan Technology & Management Ltd. is directly or indirectly a

subsidiary or affiliate of Alcan Inc., a corporation of Canada. Alcan Technology & Management Ltd. has contracts with various other subsidiaries and affiliates of Alcan Inc. to provide services and the like for such other companies in patent and other intellectual property matters.

(5) Mr. Wittemer is an engineer employed by Alcan Packaging at its Shelbyville, Kentucky facility. Alcan Packaging is a corporation having a place of business at 3850 Midland Industrial Drive, Shelbyville, Kentucky 40065. Alcan Packaging is directly or indirectly a subsidiary of Alcan Inc. and is a member of the Alcan Group.

(6) Ms. von Rohr is a clerk employed in the Intellectual Property department of Alcan Technology & Management Ltd.

(7) The order letter of October 2, 2003 of Mr. Burkhart further stated:
"Please note that unintentionally we've filed a European instead of a U.S. priority application. Please file a retroactive license."

(8) He sent an e-mail on October 12, 2003 to Mr. Burkhart stating that he wanted to quickly file the U.S. application with the petition for a retroactive license for foreign filing being filed shortly thereafter and asked permission to send a declaration and a copy of the application to Mr. Wittemer. On October 13, 2003 he received an e-mail from Mr. Burkhart that Mr. Wittemer would be in Neuhausen, Switzerland facility the next day. On October 13, 2003 he faxed the declaration to Mr. Burkhart to attach a copy of the application and secure execution by Mr. Wittemer. On October 14, 003 he received a fax message from

Ms. von Rohr that executed declaration and attached application was being sent by air carrier.

(9) The executed declaration and attached application was delivered to his office on October 16, 2003 and apparently placed in the file wrapper. It was subsequently located there, and on October 23, 2003 he sent an e-mail to Mr. Burkhart that the U.S. application was filed on October 27, 2003. On October 28, 2003 his office sent a report to Mr. Burkhart that the U.S. application had been filed.

(10) On October 30, 2003 he received an e-mail of that date from Ms. von Rohr inquiring about the petition. On the same date he sent an e-mail to Ms. von Rohr that he would send her office a letter requesting specific information so that the petition could be prepared.

(11) On November 11, 2003 he faxed and mailed a letter to Mr. Burkhart that set out in detail the information Mr. Burkhart and other persons needed to supply to him. On December 2, 2003 he sent an e-mail reminder to Mr. Burkhart. On December 3, 2003 Mr. Burkhart sent to him an e-mail that set out in detail the facts and sequence of events regarding the inadvertent filing first the European application and the subsequent discovery of such inadvertent European filing. On December 5, 2003 he sent an e-mail to Mr. Burkhart and Ms. von Rohr requesting further information concerning the declaration and petition. On December 5, 2003 he received an e-mail from Ms. von Rohr on behalf of Mr. Burkhart and herself that set out the requested additional information. On December 7, 2003 he sent an e-mail to Ms. von Rohr requesting certain further

information. On December 8, 2003 he sent an e-mail to Mr. Wittemer requesting specific information and on the same date Mr. Wittemer sent the requested information to him. On December 9, 2003 he received an e-mail from Ms. von Rohr setting out the requested information. On December 9, 2003 he sent by e-mail and fax proposed declarations to Mr. Burkhart, Mr. Wittemer, Mr. Gernet and Ms. von Rohr for their review.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting patent, declares that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Date: Dec. 23, 2003

Virgil H. Marsh

Virgil H. Marsh
Reg. No. 23,083



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No.: ATM-2360

Applicant : Joseph WITTEMER

Serial No. : 10/692,682

Filed : October 27, 2003

Title : PACKAGING BAG

DECLARATION

Hans Burkhart declares and states that:

- (1) He is a patent agent in Switzerland and is also a European patent attorney. He is not a (registered) U.S. patent agent or attorney. He does possess a detailed and intimate knowledge of U.S. patent laws.
- (2) He is employed as head of the Intellectual Property (patent) department of Alcan Technology & Management Ltd., that is a Swiss corporation having a place of business at Badische Bahnhofstrasse 16, CH-8212 Neuhausen am Rheinfall, Switzerland. Alcan Technology & Management Ltd. is directly or indirectly a subsidiary or affiliate of Alcan Inc., a corporation of Canada. Alcan Technology & Management Ltd. has contracts with various other subsidiaries and affiliates of Alcan Inc. to provide services and the like for such other companies in patent and other intellectual property matters.
- (3) Alcan Packaging is a corporation having a place of business at 3850 Midland Industrial Drive, Shelbyville, KY 40065. Alcan Packaging is directly or indirectly a subsidiary or affiliate of Alcan Inc. and is a member of the Alcan Group.

(4) Alcan Technology & Management Ltd. has a contract with Alcan Packaging to provide some of its facilities, i.e., substantially for ones located in Europe, with services in the field of intellectual property. His Intellectual Property department has responsibility for preparing and filing patent applications for inventions made by employees, consultants, etc., of the Shelbyville, KY facility of Alcan Packaging.

(5) Mr. Joseph Wittemer is an engineer employed by Alcan Packaging at its Shelbyville, KY facility. Mr. Wittemer is not a U.S. patent agent or attorney. Mr. Wittemer is a U.S. citizen and resides at 4202 Patterson Park Court, Louisville, Kentucky 40299.

(6) On September 5, 2002 Mr. Wittemer sent a request pursuant to the above-mentioned service contract to his Intellectual Property department for a search for a specific packaging form that was possibly patented by a third party company. The search was conducted by the "Information-Center" of his Intellectual Property department (Patent department). The search did not reveal any third party property rights.

(7) In the last week of September 2002 Mr. Wittemer in person visited the Patent Department at Neuhausen, Switzerland to propose a new idea to be patented. Again, based on the service contract, his office took over. An outside patent counsel (not an employee of Alcan), located in Europe, drafted an application text in the German language. An outside translation office translated the text into the English language. Mr. Wittemer agreed in general with the English text and added only one revision to it. The outside counsel picked-up the

revision and inserted the revision into the German text and sent the text to his office. From said outside counsel accompanying said text, his office received the outside counsel's letter dated December 11, 2002. In said letter it said in the German language: "Enclosed find the ready-to-file text in the German language for priority filling and the respective English translation." [English language translation]

(8) Ms. Esther von Rohr is a clerk employed in the Intellectual Property department of Alcan Technology & Management Ltd. at Neuhausen, Switzerland. Ms. von Rohr is responsible for all priority patent application filings and foreign patent application filings.

(9) Following her routine, Ms. von Rohr prepared the formal papers for the European Patent Office (EPO) and filed the German language version of the specification ("ready-to-file text in the German language for priority filing") in the European Patent Office (via the Swiss Patent Office) on December 12, 2002. Based on his recollection, because of the specification being in the German language and probably caused by other stress factors , Ms. von Rohr prepared the formal papers and signed them, and then he co-signed them, without he or Ms. von Rohr recognizing the problem involved. Subsequently, Ms. von Rohr sent the request and the specifications to the Swiss Patent Office, that handles European applications filed in Switzerland for the EPO.

(10) Neither he nor Ms. von Rohr paid any attention after the filing of the EPO application because Ms. von Rohr was very busy with getting all her duties done a short time before the holiday season and he went on a four week

vacation over the holiday season. The application number supplied by the EPO was subsequently docketed by another clerk, Mr. Samuel Gernet, who was not aware of the rules and regulations regarding U.S. inventors and filings in foreign countries.

(11) He checked the initial (priority) patent application filings through the Patent department of Alcan Technology & Management Ltd. since 2000, the year the Patent department had the last priority filing in the U.S. He counted a total of about 108 original filings, that is, 75 in Europe, 24 in Germany, and 7 in Switzerland (all in the German language) plus, one filing in the U.K., done by an outside U.K. Counsel, and one filing in the U.S. going back to the year 2000 as aforementioned.

(12) The matter of filing Mr. Wittemer's invention first outside of the U.S. without a license for filing, only arose and came to his attention when Ms. von Rohr started the preparations for foreign filings and sending the order for the U.S.-filing to the office of Virgil H. Marsh, Esq., Fisher Christen & Sabol, Washington, D.C. on October 2, 2003. He immediately informed Mr. Marsh of the inadvertent foreign filing of Mr. Wittemer's invention in his October 2, 2003 letter to Mr. Marsh. He did not realize until that point in time that a license for foreign filing had been necessary to first file the European application. The filing first of the European application without first obtaining a license for foreign filing was inadvertent. The error of not first filing the application in the U.S. was inadvertent.

(13) Mr. Marsh's office on October 7, 2003 received my letter and order to file the U.S. application. On October 12, 2003, Mr. Marsh sent an e-mail to him asking permission to send a declaration and a copy of the application directly to Mr. Wittemer. On October 13, 2003 he sent an e-mail to Mr. Marsh that Mr. Wittemer would be in the Neuhausen, Switzerland facility the next day. On October 13, 2003 Mr. Marsh faxed the declaration to him to attach a copy of the application and secure execution by Mr. Wittemer. The executed declaration and attached copy of the application was sent on October 14, 003 by air carrier to Mr. Marsh.

(14) He was informed that the U.S. application was filed on October 28, 2003.

(15) He received by fax and airmail a letter dated November 11, 2003 from Mr. Marsh that set out in detail the information he and other persons needed to supply to Mr. Marsh so that Mr. Marsh could prepare the necessary declaration from them to support the petition for a retroactive license for foreign filing. He made a detailed investigation of the matter. On December 3, 2003 he sent to Mr. Marsh an e-mail that set out in detail the facts and sequence of events regarding the inadvertent filing first the European application and the subsequent discovery of such inadvertent European filing. On December 5, 2003 he received an e-mail from Mr. Marsh requesting certain further information concerning the declaration and petition.

(16) He avers that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy

order, and that the subject matter in question is not of a nature that would be subject to a secrecy order.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting patent, declares that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Date: December 11, 2003



Hans Burkhart



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No.: ATM-2360

Applicant : Joseph WITTEMER

Serial No. : 10/692,682

Filed : October 27, 2003

Title : PACKAGING BAG

DECLARATION

Joseph Wittemer declares and states that:

- (1) He is the applicant in the above-mentioned U.S. application.
- (2) He is a citizen of the United States Of America and resides at 4202

Patterson Park Court, Louisville, Kentucky 40299.

(3) He is an engineer employed by Alcan Packaging at its Shelbyville, Kentucky facility. Alcan Packaging is a corporation having a place of business at 6850 Midland Industrial Drive, Shelbyville, Kentucky 40065. Alcan Packaging is directly or indirectly a subsidiary of Alcan Inc. and is a member of the Alcan Group. He is not a U.S. patent attorney or attorney.

(4) He made the invention disclosed in the above-mentioned application in the United States Of America. He was not aware of the rules and regulations regarding U.S. inventors and filing in foreign countries.

(5) Alcan Technology & Management Ltd., that is a Swiss corporation having a place of business at Badische Bahnofstrasse 16, CH-8212 Neuhausen am Rheinfall, Switzerland is a member of the Alcan Group. Alcan Technology & Management, Ltd. has a contract with the Shelbyville facility of the Alcan group to provide services and other intellectual property matters.

(6) On September 5, 2002 he sent a request pursuant to the above-mentioned service contract to the Intellectual Property department of Alcan Technology & management Ltd. for a search for a specific packaging form that was possibly patented by a third party company. The search was conducted by the "Information-Center" of the Intellectual Property department (Patent department). The search did not reveal any third party property rights.

(7) In the last week of September 2002 he in person visited the Patent Department at Neuhausen, Switzerland to propose a new idea to be patented. Based on the service contract, the Patent department took over. Subsequently, he received an English-language version of a draft patent application for his invention. He agreed in general with the English text and added only one revision to it. Later he was advised that the European patent application had been filed on December 12, 2002.

(8) On December 8, 2003 he received an e-mail message from Virgil H. Marsh, Esq., of Fisher Christen & Sabol, Washington, D.C. Mr. Marsh's e-mail advised that a petition for a retroactive license for foreign filing had to be obtained in his above-mentioned U.S. patent application, and requested certain information from him so that his declaration could be prepared. On the same date he sent the requested information to Mr. Marsh by e-mail. This was the first time that he learned that such petition for a retroactive license for foreign filing was necessary.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C.

1001, and that such willful false statements may jeopardize the validity of the application or any resulting patent, declares that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Date: December 10, 2003

Joe Wittemer
Joseph Wittemer



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Docket No.: ATM-2360

Applicant : Joseph WITTEMER

Serial No. : 10/692,682

Filed : October 27, 2003

Title : PACKAGING BAG

DECLARATION

Samuel Gernet declares and states that:

- (1) He is employed as a clerk in the Intellectual Property (Patent) department of Alcan Technology & Management Ltd., at Badische Bahnhofstrasse 16, CH-8212 Neuhausen am Rheinfall, Switzerland.
- (2) When the application number for the European patent application, that is the priority application for the above-mentioned U.S. application, was received from the European Patent Office he docketed the one year period for filing in other countries. He was not aware of the rules and regulations regarding U.S. inventors and filings in foreign countries.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting patent, declares that all statements made of her own knowledge are true and all statements made on information and belief are believed to be true.

Date: 12/12/2003

Samuel 

Samuel Gernet



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No.: ATM-2360

Applicant : Joseph WITTEMER

Serial No. : 10/692,682

Filed : October 27, 2003

Title : PACKAGING BAG

DECLARATION

Esther von Rohr declares and states that:

(1) She is employed as a clerk in the Intellectual Property (Patent) department of Alcan Technology & Management, Ltd., that is a Swiss corporation having a place of business at Badische Bahnhofstrasse 16, CH-8212, Neuhausen am Rheinfall, Switzerland. Mr. Hans Burkhart is head of the Intellectual Property department.

(2) She is not a patent agent or attorney in the United States or anywhere else in the world.

(3) In the last week of September 2002 Mr. Joseph Wittemer in person visited the Patent Department at Neuhausen, Switzerland to propose a new idea to be patented. Mr. Wittemer is an engineer employed by Alcan Packaging at its Shelbyville, KY facility. The Intellectual Property (Patent) department of Alcan Technology & Management Ltd. has a contract with Alcan Packaging to provide some of its facilities, i.e., substantially for ones located in Europe, with services in the field of intellectual property. The Intellectual Property department has responsibility for preparing and filing patent applications for inventions made by employees, consultants, etc., of the Shelbyville, KY facility of Alcan Packaging.

(4) Based upon such service contract, the Intellectual Property department took over the matter. An outside patent counsel (not an employee of Alcan), located in Europe, drafted an application text in the German language. An outside translation office translated the text into the English language. The outside counsel then revised the German text and sent the text to the Patent department. From said outside counsel accompanying said text, the Patent department received the outside counsel's letter dated December 11, 2002. In said letter it said in the German language: "Enclosed find the ready-to-file text in the German language for priority filing and the respective English translation."

[English language translation]

(5) She is responsible for all priority patent application filings and foreign patent application filings made by the Patent department.

(6) Following her routine, she prepared the formal papers for the European Patent Office (EPO) and filed the German language version of the specification ("ready-to-file text in the German language for priority filing") in the European Patent Office (via the Swiss Patent Office) on December 12, 2002. Based on her recollection, because of the specification being in the German language and being very busy at the time with the accompanying stresses, Ms. von Rohr prepared the formal papers and signed them, and then Mr. Burkhart co-signed them, without her or Mr. Burkhart recognizing the problem involved. Subsequently, she sent the request and the specifications to the Swiss Patent Office, that handles European applications filed in Switzerland for the EPO.

(7) She did not pay any attention after the filing of the EPO application because she was very busy and under stress getting all her duties done a short time before the holiday season. Mr. Burkhart was about to leave on a four week vacation over the holiday season. The application number supplied by the EPO was subsequently docketed by another clerk, Mr. Samuel Gernet, who was not aware of the rules and regulations regarding U.S. inventors and filings in foreign countries.

(8) She only had one other original (priority) filing in the U.S. among the about 108 original filings that she had handled going back to the year 2000.

(9) The matter of filing Mr. Wittemer's invention first outside of the U.S. without a license for filing, only arose and came to her attention when she started the preparations for foreign filings and sending the order for the U.S.-filing to the office of Virgil H. Marsh, Esq., Fisher Christen & Sabol, Washington, D.C. on October 2, 2003. Mr. Burkhart immediately informed Mr. Marsh of the inadvertent foreign filing of Mr. Wittemer's invention in his October 2, 2003 letter to Mr. Marsh. On December 7, 2003 she received another e-mail from Mr. Marsh and on December 9, 2003 she e-mailed the requested information to Mr. Marsh.

(10) She and Mr. Burkhart received e-mails dated December 5, 2003 from Mr. Marsh that requested certain further information concerning the declarations and petitions. On December 5, 2003 she sent an e-mail on behalf of her and Mr. Burkhart to Mr. Marsh that set out the additional information that had been requested by Mr. Marsh.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting patent, declares that all statements made of her own knowledge are true and all statements made on information and belief are believed to be true.

Date: December 11, 2005

Esther von Rohr

Esther von Rohr